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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,321	10/03/2003	Herbert Andre Jansen	05015228-92US1 PTN/df	9461
93758 7590 02/28/2011 Ogilvy Renault LLP (Zimmer Cas) 1 Place Ville Marie Suite 2500 Montreal, QC H3B 1R1 CANADA			EXAMINER BOLES, SAMEH RAAFAT	
			ART UNIT 3775	PAPER NUMBER
			MAIL DATE 02/28/2011	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/677,321

**Applicant(s)**

JANSEN ET AL.

**Examiner**

SAMEH BOLES

**Art Unit**

3775

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 February 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5-8 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3 and 5-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11/8/04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after the final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 17, 2011 has been entered. Accordingly, claims 3, 5-8 are amended, Claims 1-2 are withdrawn, claim 4 is cancelled, and claims 3, 5-8 are examined in this office action.

#### ***Claim Rejections - 35 USC § 112***

Claim 3 was previously rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement and for containing a subject matter of "pointy tips" which was not described in the specification.

Applicant has amended and deleted the new subject matter from the claim, therefore the rejection is moot.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3, 5-6, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis (US. Pat. No. 5171248) in view of Brosseau et al. (US. Pat. No. 6450978 B1).

Ellis teaches an apparatus for obtaining an axis of an intramedullary canal of an exposed bone (see modified figure 3 below) comprising: a stem portion (12) having a leading end insertable in an intramedullary canal of the bone through an opening in the bone, and being adapted to be handled by a following end thereof; and a tip portion (see modified figure 3 below) at the leading end of the stem portion, the tip portion having two fingers (32 and 34, Fig. 5) actuatable (see Figs. 1-3) from the following end of the stem portion to extend radially (Fig. 3) from the stem portion (12) with tips (72) of the fingers (32 and 34) being equidistantly spaced (Fig. 3) from the stem portion to center the leading end of the stem portion in the intramedullary canal by contacting the surface of the intramedullary canal, wherein the fingers are pivotally mounted (36 and 28) to one another, wherein the fingers are biased to be retracted radially (Fig. 1), so as to facilitate an insertion of the stem portion in the intramedullary canal. The stem portion is graduated (78) on an outer surface thereof to indicate a depth of insertion of the stem portion in the intramedullary canal (Fig. 3).

Ellis fails to teach a combination with a position tracking system and a computer-assisted surgery system comprising a detectable device trackable in space.

Brosseau teach a surgical tool (20, Figs. 1 and 2) with a combination with a position tracking system (22, Fig. 1) and a computer-assisted surgery system (12, Figs. 1 and 3) comprising a detectable device trackable (42, Fig. 2) secured to the surgical device (20) in space for tracking position and orientation (abstract).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify the apparatus of Ellis with a combination with a position tracking system and a computer-assisted surgery system comprising a detectable device trackable in space in view of Brosseau for effectively tracking the position of the apparatus with respect to the anatomy bone.

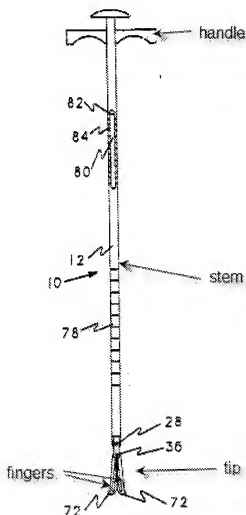


FIG. 3

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Brosseau and further in view of Kuslich et al. (US. pat. No. 6620162).

Ellis in view of Brosseau fails to teach a flared adapter slidably mounted on the stem portion, the flared adapter being flared toward the following end of the stem portion to engage with a surface of the intramedullary canal at the opening of the intramedullary canal, to center the stem portion in the intramedullary canal.

Kuslich teaches a flared adapter (100) slidably mounted on the stem portion (14), the flared adapter being flared toward the following end of the stem portion to engage with a surface of the intramedullary canal at the opening of the intramedullary canal (Fig. 5), to center the stem portion in the intramedullary canal and to control the insertion depth of the stem.

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify the combination device of Ellis in view of Brosseau with a flared adapter further in view of Kuslich for effectively centering the stem portion in the canal and controlling the insertion depth of the stem.

#### ***Response to Arguments***

Applicant's arguments with respect to claims have been fully considered but they are not persuasive.

Applicant argues that Ellis is not concerned in any way by the digitization of an axis of the intramedullary canal; also applicant argues that the computer-assisted

surgery system of Brosseau is not concerned in any way by the digitization an intramedullary canal of the bone from the orientation of the apparatus.

Examiner respectfully disagrees since it is noted that "while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Also, since a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

### ***Conclusion***

All claims are drawn to the same invention previously claimed in the application and could have been finally rejected on the grounds and art of record in the next Office action if they had been previously entered in the application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAMEH BOLES whose telephone number is (571)270-5537. The examiner can normally be reached on Monday - Friday 7:30am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas C. Barrett can be reached on (571)272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SAMEH BOLES/  
Examiner, Art Unit 3775

/EDUARDO C. ROBERT/  
Supervisory Patent Examiner, Art Unit 3733